

JAN 12 2007

Application No.: 10/664,054

Docket No.: 58998US002

REMARKSI. Election/Restriction

The Examiner indicated that claims 34 through 38 submitted with the prior Amendment are drawn to a non-elected species, and therefore were withdrawn from consideration. Applicant notes that there is a typographical error in the second paragraph explaining the restriction requirement, where the penultimate sentence reading "Accordingly, claims 24-38 are withdrawn from consideration . . ." should instead refer to claims 34-38, as noted earlier in that section and in the Office Action Summary transmittal page.

II. Rejection of Claims Under 35 U.S.C. 102

The Examiner rejected claims 21 through 25, 27, 29, and 30 under 35 U.S.C. 102(b) as being anticipated by WO 01/45559 A1 (Peterson). The Examiner indicated that Peterson teaches the process of claim 21 for laser marking a dental container, including the steps of "providing a container . . . formed from a thermoplastic material *and including a laser enhanced outer layer . . .*" Office Action at page 4 (text omitted where shown; emphasis added). The Examiner noted that "the laser enhanced outer layer is an integral part of the container, i.e., a coating, [and] hence it is submitted that the container is made from a laser-enhanced material." Office Action at 4. Furthermore, the Examiner stated, Peterson "also teaches directly laser marking a container, hence teaching a container made from a laser-enhanced material.", referring to Peterson at page 2, lines 26-27. Applicants respectfully request reconsideration of the rejection for at least the following reasons.

Peterson discloses an article having an identification mark, and further states that the article comprises a body having an exterior surface with a certain color, and that a polymer coating having a color that contrasts with the color of the exterior surface "extends over a certain region of the exterior surface." See Page 2, lines 26-29. Peterson then describes a method of marking an article, including "the act of directing a laser beam toward the coating with sufficient power to cause the coating to undergo a chemical reaction and create an identification mark." Page 3, line 31 through page 4, line 5. Peterson goes on to describe how the laser is moved as needed to create a desired alphabetic, numeric, or other identification mark, which in the embodiment described results from "the portion of the coating within the desired area of the

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identification mark [being] essentially completely volatilized *so that the exterior surface 18 is readily visible and contrasts with the adjacent areas of the coating 20.*" Page 5, line 26 through page 6, line 2 (emphasis added). In other words, coating 20 and exterior surface 18 are discrete, independent layers or components and the application of a laser to one – the coating – causes it to contrast with the other – the exterior surface. If, as the Examiner contends, the article in Peterson is a "container made from a laser-enhanced polymer" as specified in claim 21, then the application of the laser to coating 20 would have no effect on the coating that differentiates it from the effect on the underlying exterior surface 18. Stated another way, the "container" described in Peterson is *made from* a non-laser-enhanced material, and coated with a second material that may be laser-enhanced. That disclosure cannot anticipate claim 21, which requires providing "a container made from a laser-enhanced polymer." Because the remaining claims depend from claim 21, which is allowable for at least the reasons noted, those claims are similarly in condition for allowance.

III. Rejection of Claims Under 35 U.S.C. 103

The Examiner rejected claims 21 through 33 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,100,320 (Martin et al.) in view of U.S. Patent No. 5,977,514 (Feng et al.), and further in view of Peterson, mentioned above. With regard to claim 21, the Examiner indicated that Martin et al. does not teach forming a marking using laser radiation, but that Peterson teaches laser marking a product container with informational data, and Feng et al. teaches laser-marking nylon using a Nd:YAG laser. Office Action at pages 4-5. The Examiner's motivation to combine the references in the manner provided is, it appears, that Peterson's disclosure of laser-marking containers is sufficient to tie together a reference disclosing containers (Martin et al.) with a reference disclosing laser-marking (Feng et al.). Applicant respectfully requests reconsideration of the rejection.

As noted in response to the prior Office Action, Martin et al. does not teach forming a marking of any kind on the cartridge described in that reference, whether by laser, ink printing, or pencil. The reference is altogether silent on the subject of marking, which makes any combination of that reference with another reference that discloses laser marking suspicious because there is no apparent motivation to combine. As set forth in the M.P.E.P., at Section 2143.01, "[t]he mere fact that the references can

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be combined . . . does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination." In this case, the proposed motivation to combine suggested by the Examiner – "improved process control, reduced waste and ease in modifying the required mark in a short period of time" – are supplied by the Examiner, not the prior art.

Furthermore, even if the references were combined in the manner proposed by the Examiner, the claimed invention would not result. As noted in Section II above, Peterson does not disclose providing a "container formed from" a laser-enhanced polymer, nor does it suggest somehow blending the material of the coating layer with the material of the underlying container to try to arrive at the claimed invention. Neither do Martin et al. or Feng et al. In summary, no matter in what order the references are applied, the invention of claim 21 cannot be said to be obvious because there is no motivation to combine them in the manner proposed, and even if so combined the claimed invention does not result. Claim 21, and the claims that depend therefrom, are thus believed to be allowable over the prior art of record.


Claims 26 and 28 were also rejected under 35 U.S.C. 103(a) as being unpatentable over Peterson in view of Feng et al., and claims 31 through 33 were rejected under the same section over Peterson. In each case, Applicant respectfully requests reconsideration of the rejection. All five dependent claims are patentable over Peterson and Feng et al. for the reasons mentioned above in support of the patentability of claim 21, and are therefore similarly in condition for allowance.

V. Conclusion

Claims 21 through 33 are believed to be in condition for allowance for at least the reasons presented above. If a telephonic interview with Applicants' undersigned representative would be useful in resolving any remaining matters related to the application, the Examiner is invited to contact the undersigned at 651-736-4050.

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Date

Respectfully submitted,

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